

Application No. 10/696,845

Amendment and Response dated April 26, 2010

Reply to Office Action of January 26, 2010

Page 9

**REMARKS/ARGUMENTS**

Reconsideration is respectfully requested in view of the remarks and amendments presented herein.

Claims 1-17 and 23-42 are pending in this application. Claims 5-7, 15-17, 24, 25, 28, 29, 31, 32, and 34 have been withdrawn from consideration by the Examiner pursuant to 37 C.F.R. §1.114. By this Amendment, claims 1, 23, 30, and 39 have been amended. Moreover, claims 12 and 13 have been cancelled in view of the amendment to claim 1. Claim 14 has been amended in view of the cancellation of claim 13. Claim 26 has been cancelled in view of the amendment to claim 23. Claim 33 has been cancelled in view of the amendment to claim 30. New claim 43 has been added. Support for the amendments to the claims may be found, for example, in the specification at page 5, line 1 – page 6, line 9, and in the figures. No new matter is added.

In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

**I. Rejections Under 35 U.S.C. §103**

**A. Strecker in view of Chevalier Jr.**

The Examiner has rejected claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, 35, and 39-42 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,653,748 to Strecker ("Strecker") in view of U.S. Patent No. 5,401,257 to Chevalier Jr. et al. ("Chevalier"). The Examiner has acknowledged that "Strecker fails to disclose a visual marker comprising a colored loop extending around the prosthesis that is a different color than the releasing means." *See* Office Action, paragraph bridging pages 2-3. Nevertheless, the Examiner has alleged that "[i]t would have been obvious for one having ordinary skill in the art at the time the invention was made to combine the marker bands with colorant of Chevalier with the delivery device of Strecker in order to enhance the trackability of the implant." *See* Office Action page 3, second

Application No. 10/696,845

Amendment and Response dated April 26, 2010

Reply to Office Action of January 26, 2010

Page 10

full paragraph. Applicants respectfully disagree. Reconsideration is respectfully requested in view of the amendments and remarks herein.

By this Amendment, claims 12, 13, 26, and 33 are cancelled, rendering the rejection moot with regard to those claims.

Without conceding the propriety of the rejections, independent claims 1, 23, 30 and 39 have been amended to advance prosecution. Specifically, each of independent claims 1, 23, 30, and 39 has been amended to recite that the means for releasably securing the prosthesis includes a mesh and to recite that visual marker is in the form of a colored band extending around the mesh. Strecker fails to disclose or suggest a visual marker in the form of a colored band which extends around mesh, and Chevalier fails to cure the deficiencies of Strecker.

Chevalier is directed to a ureteral stent having an enlarged entry tip. Nowhere does Chevalier teach or suggest a visual marker in the form of a colored band which extends around mesh as recited in amended claims 1, 23, 30, and 39.

Rather, the visual marker of Chevalier is created using a laser. In particular, Chevalier teaches that “[t]hese markings, as well as others that indicate the size, length and manufacturer of the stent, can be placed on the stent using a laser scribing system” and that “[t]he markings are also relieved into the surface of the tube.” *See* column 7, lines 58-61, and column 8, lines 17-18, of Chevalier.

Thus, neither Strecker nor Chevalier disclose or suggest a visual marker in the form of a colored band which extends around mesh as recited in amended independent claims 1, 23, 30, and 39. Therefore, Strecker and Chevalier fail to disclose or suggest all of the features of independent claims 1, 23, 30, and 39 as amended herein.

Application No. 10/696,845

Amendment and Response dated April 26, 2010

Reply to Office Action of January 26, 2010

Page 11

Accordingly, independent claims 1, 23, 30, and 39 as amended are not obvious over Strecker and Chevalier.

Claims 2-4, 8, 14, and 40 all depend directly or indirectly from amended claim 1. Accordingly, claims 2-4, 8, 14, and 40 are not obvious over Strecker and Chevalier for the same reasons discussed above with respect to amended claim 1. Indeed, there is no disclosure or suggestion in Strecker and Chevalier of the subject matter of claims 2-4, 8, 14, and 40 as presented herein.

Claims 27 and 41 depend from amended 23. Accordingly, claims 27 and 41 are not obvious over Strecker and Chevalier for the same reasons discussed above with respect to amended claim 23. Indeed, there is no disclosure or suggestion in Strecker and Chevalier of the subject matter of claims 27 and 41 as presented herein.

Claims 35 and 42 depend from amended 30. Accordingly, claims 35 and 42 are not obvious over Strecker and Chevalier for the same reasons discussed above with respect to amended claim 30. Indeed, there is no disclosure or suggestion in Strecker and Chevalier of the subject matter of claims 35 and 42 as presented herein.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) of claims 1-4, 8, 12-14, 23, 26, 27, 30, 33, 35, and 39-42 is respectfully requested.

**B. Strecker in view of Chevalier and further in view of Ravenscroft**

The Examiner has rejected claims 9–11 under 35 U.S.C. §103(a) over Strecker in view of Chevalier and further in view of U.S. Patent No. 5,480,423 to Ravenscroft ("Ravenscroft"). The Office Action acknowledged that Strecker and Chevalier do "not disclose that his prosthesis expands to a larger radius and a shorter length upon implantation." *See* Office Action, page 3, fourth full paragraph. Nevertheless, the Office Action has alleged that "[i]t would have been

Application No. 10/696,845

Amendment and Response dated April 26, 2010

Reply to Office Action of January 26, 2010

Page 12

obvious to one having ordinary skill in the art at the time the invention was made to combine the stent of Ravenscroft with the delivery device of Strecker as modified by Chevalier in order to provide a concentrated expansion force within a body lumen, which can be accurately tracked by the operator throughout the insertion process.” *See* Office Action, paragraph bridging pages 3-4. Applicants respectfully traverse the rejection and request reconsideration in view of the amendments and remarks herein.

To advance prosecution and not in acquiescence of the rejection, independent claim 1 has been amended. For at least the reasons mentioned above, Strecker and Chevalier fail to disclose or suggest all of the features of independent claim 1 as amended.

The Examiner has cited Ravenscroft merely for a disclosure of “a length shortening self-expanding stent.” *See* Office Action, page 3, fifth full paragraph. Ravenscroft, however, fails to cure the deficiencies of Strecker and Chevalier. Whether considered alone or in combination, Strecker, Chevalier, and Ravenscroft fail to disclose or suggest all of the features of amended claim 1.

Accordingly, independent claim 1 as amended is not obvious in view of Strecker, Chevalier, and Ravenscroft.

Claims 9–11 depend either directly or indirectly from claim 1 and, thus, also are not rendered obvious in view of Strecker, Chevalier, and Ravenscroft. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) with respect to claims 9-11 are respectfully requested.

**C. Strecker in view of Chevalier and further in view of Fischell**

The Examiner has rejected claims 36–38 under 35 U.S.C. §103(a) as allegedly being unpatentable over Strecker in view of Chevalier and further in view of U.S. Patent No. 5,792,144

Application No. 10/696,845

Amendment and Response dated April 26, 2010

Reply to Office Action of January 26, 2010

Page 13

to Fischell et al. ("Fischell"). The Examiner has acknowledged that Strecker and Chevalier do "not disclose that the radiopaque bands comprise silicone." *See* Office Action, page 4, second full paragraph. Nevertheless, the Examiner has alleged that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the silicone coating with marker bands of Strecker as modified by Chevalier in order to provide a durable visible marker for the operator." *See* Office Action, page 4, fourth full paragraph.

Applicants respectfully traverse the rejection and request reconsideration in view of the amendments herein.

To advance prosecution and not in acquiescence of the rejection, independent claims 1, 23, and 30 have been amended. For at least the reasons mentioned above, Strecker and Chevalier fail to disclose or suggest all of the features of independent claims 1, 23, and 30.

The Examiner has relied on Fischell merely for a disclosure of a stent-delivery catheter including bands of a radiopaque metal coated in silicone. Fischell, however, fails to disclose or suggest all of the features of amended independent claims 1, 23, and 30. Accordingly, Fischell fails to overcome the deficiencies of Strecker and Fischell with respect to amended independent claims 1, 23, and 30.

Accordingly, independent claims 1, 23, and 30 would not have been rendered obvious by Strecker, Chevalier, and Fischell. Claim 36 depends from claim 1, claim 37 depends from claim 23, and claim 38 depends from claim 30. Thus, claims 36-38 also would not have been rendered obvious by Strecker, Chevalier, and Fischell. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) of claims 36-38 are respectfully requested.

Application No. 10/696,845  
Amendment and Response dated April 26, 2010  
Reply to Office Action of January 26, 2010  
Page 14

**II. Conclusion**

This application is believed to be in condition for allowance. Favorable action thereon is therefore respectfully solicited.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned at the telephone number given below.

The Examiner is authorized to charge any claim fees which are due to Deposit Account No. 08-2461. Moreover, the Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this submission or any future submission pursuant to 37 C.F.R. § 1.136.

Respectfully submitted,



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Andrea M. Wilkovich  
Registration No.: 53,773

HOFFMANN & BARON, LLP  
6900 Jericho Turnpike  
Syosset, NY 11791  
(973) 331-1700